

B14

wherein angle  $\alpha$ , angle  $\beta$ , and satisfy the relationship  $\alpha \approx 2.5\gamma$ .

### REMARKS

Claims 1-49, 55, 57-61, 64-68, 73 and 76-83 are pending. By this Amendment, the title and claims 1, 6, 10, 16, 20, 26, 30, 36, 40, 44-46, 55, 57-61, 64, 73, 76, 77, 81 and 82 are amended. Further, claims 50-54, 56, 62, 63, 69-72, 74 and 75 are canceled. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies extended by Examiner Boehler to Applicants' undersigned representative during a personal interview conducted on January 10, 2001. The substance of what was discussed during the personal interview is set forth below.

At the outset, Applicants respectfully request that the finality of the September 12, 2000 Office Action be withdrawn because it is premature and therefore improper. In particular, claims 59-61 were improperly rejected under 35 U.S.C. §103 over Husted in view of Boyer. Specifically, neither Husted or Boyer teaches or suggests an engine disposed on the frame in front of the seat, as specified in the claims 59-61. In Husted and Boyer, the respective engines are disposed behind the seats, as agreed during the interview.

Further, the subject matter of dependent claims is not taught in the prior art. For example, the subject matter of claim 56, now incorporated into independent claim 55, is not taught in Marier, because Marier teaches an angle of no more than about 5°, whereas claim 55 specifies an angle of 10° – 20°.

Accordingly, withdrawal of the finality of the rejection and entry of the accompanying amendments as a matter of right are respectfully requested.

Even if the finality of the Final Rejection is not withdrawn and the amendments are not entered as a matter of right, the Amendment should nevertheless be entered because the Amendment: a) places the application in condition for allowance (for the reasons discussed herein); b) does not raise any new issues requiring further search and/or consideration since

the amendments add more clarity to the claims, address objections/rejections raised by the Examiner in the Final Office Action and amplify issues contained in the original claims; c) satisfies a requirement of form asserted in the previous Office Action; and d) places the application in better form for appeal, should an appeal be necessary. The Amendment is necessary and was not earlier presented because it made in response, at least in part, to arguments raised in the Final Rejection. Entry of the amendment is thus respectfully requested.

The drawings were objected to as failing to show toe-holds and a steering shaft positioned over the engine at a angle of less than 45° from vertical. Applicants proposed Request for Approval of Drawing Changes filed on June 22, 2000 were disapproved. Applicants withdraw that Request and request that the attached Request for Approval of Drawings Corrections be substituted for the proposed drawing corrections filed on June 22, 2000.

First, with respect to the proposed addition of toe-holds 145 to Figs. 2 and 3, the specification points out that, under normal operating conditions, the rider's feet 146 will rest on a forward portion of the sideboards. Preferably, toe-holds 145 are disposed above these forward portions and permit the rider to releaseably secure himself to the vehicle. See page 10, lines 6-7 of the original specification. Thus, there is support for toe-holds above the rider's toes. Applicants, by showing the toe-holds in Figs. 1 and 2, are merely applying the familiar rule that the drawings and the specification may be amended to conform to each other and that the added matter will not be deemed "new matter". *See, e.g., In re Application of Heinle*, 145 USPQ 131 (CCPA 1965). One of ordinary skill in the art, armed with the knowledge from the specification that the toe-holds are above the toes (as the term "toe-holds" suggests), would have understood that the toe-holds are necessarily located just above the position of the rider's toes during operation of the vehicle. If the toe-holds were

positioned too far above the toes, they would not serve the purpose of allowing the rider to "releasably secure himself to the vehicle", as explained in the original specification. If the toe-holds were not positioned near the forward end of each sideboard, as shown in the proposed correction to Figs. 2 and 3, they would not be positioned to hold the rider's toes. The original specification state that "the rider's feet are positioned on a forward portion of the side-boards," which is where Applicants have proposed to add the toe-holds. Thus, the proposed positioning in Figs. 2 and 3 is accurate and consistent with the original specification, as would have been understood by the ordinarily skilled artisan in the snowmobile art. Thus, Applicants respectfully submit that the proposed change to Figs. 2 and 3 to show the location of the toe-holds is fully supported by the original specification. In this connection, claim 73 has been amended to recite that the toe-holds are positioned above the rider's toes (v. forward portion of each sideboard, as previously recited) for allowing the rider to releasably secure himself to the snowmobile.

Second, the proposed change to Fig. 14 is fully supported by Figs. 2 and 3, which shows that the angle of the steering shaft is measured from the vertical, not the horizontal. This angle was inaccurately shown in original Fig. 14 and the proposed change to Fig. 14 makes it consistent with the specification, which states that the angle in question is less than about 45° from vertical, but more preferably between 25° and 40° from vertical. The angle in original Fig. 14 is clearly not 25°-40° from vertical. Accordingly, the proposed change to Fig. 14 is supported by the original specification, as agreed during the personal interview. See page 4, lines 32-34. Moreover, the proposed change to Fig. 2 to include the engine is supported by Fig. 14, which shows the engine just beneath the handle bars 132.

Withdrawal of the objections to the drawings is respectfully requested.

The drawings were also objected to based on an apparent lack of consistency between Figs. 2 and 3, and Fig. 4. The Examiner refused to enter Applicants' proposed corrections to Figs. 2 and 3 that were filed on June 22, 2000. Reconsideration is respectfully requested.

The position of the windshield in the attached proposed drawing corrections to Figs. 2 and 3 is identical to the position of the windshield shown in original Figs. 1 and 2. However, Applicants' new proposed correction is to revise Figs. 2 and 3 to reduce the thickness of the rider's fingers (the size of which were exaggerated and disproportional in the original drawings) to enable a small degree of movement of the handlebars. That small degree of movement is consistent with the relatively small degree of movement shown in Fig. 4. The relatively large degree of movement (approximately 90°) shown in Fig. 4 was for the purpose of illustrating that the steering wheel space would not interfere with the rider's space. It is not necessary for the steering wheel to be rotatable to the extent shown in Fig. 4. Moreover, one of ordinary skill in the art viewing Figs. 2-4 would have recognized the schematic nature of the drawings and would have designed the interaction of the handle bars with the windshield so as to enable normal operation of the snowmobile. Thus, the proposed drawing changes are consistent with the original claims and specification which recite a steering wheel that allows steering of the skis. As positioned in original Figs. 2 and 3, as the Examiner points out, it may not have been clear that steering was enabled. Applicants' correction of that perceived error does not constitute new matter. *See, e.g., In re Oda*, 170 USPQ 268, 272 (CCPA 1971) (one skilled in the art would appreciate not only the existence of error in the specification, but what the error is. As a corollary, it follows that when the nature of this error is known, it is also known how to correct it).

Accordingly, withdrawal of the objection to the drawings is respectfully requested.

Fig. 1 was objected to as failing to include a "Prior Art" label. Enclosed with the attached Request for Approval of Drawings Corrections is a marked-up copy of Fig. 1 adding a "Prior Art" label. Withdrawal of the objection is respectfully requested.

Claims 1-49, 54-58, 61, 64-68 and 77-83 were rejected under 35 U.S.C. §101. This rejection is respectfully traversed.

The mere inclusion of a person or parts of a person in a claim does not render a claim as non-statutory subject matter. It is believed that the Examiner recognizes this principle since many of the claims that recite a snowmobile defined at least in part in terms of its relation to the rider were not rejected under 35 U.S.C. §101. For example, claims 63, 69 and 73, at least as set forth in the June 22, 2000 Amendment, all define a snowmobile in terms of sideboards or foot rests that are suitable for placement of the rider's feet thereon.

The claims in this application are directed to a snowmobile. For example, claim 1 sets forth a snowmobile including a frame, an engine, a drive track, two skis, a seat, and a steering device. This is statutory subject matter. The fact that these elements, in some cases, are arguably defined as dimensioned to enable the rider to assume a certain orientation does not render that subject matter non-statutory. An Applicant can be his or her own lexicographer and is not forced to define the invention solely in terms of dimensions of the vehicle - the Examiner cannot force an Applicant to claim his or her invention in terms of dimensions if the Applicant chooses a different route. *See, e.g., Banyan Licensing, L.C. v. Allied Foam & Packing*, 2000 WL 1671797 (N.D. Ohio, 2000) (upholding validity of a claim under 35 U.S.C. §112 for a claim drawn to a pillow having a longitudinal axis "no less [in length] than that of a human thigh"). In fact, an applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. MPEP §2173.01. A claim may not be rejected solely because of the type of language used to define

the subject matter for which patent protection is sought. *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971).

Nor can the Examiner reject the claims just because Applicants have chosen a claim style that is not the Examiner's preferred claim style. As set forth in the MPEP §2173.02, "some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners . . . should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement." This is especially true in this case because the selected language is precise and one of Applicants' claim features is directed to a novel snowmobile configuration that enables a unique and non-obvious positioning of the rider on the snowmobile. This cannot be done without reference to the rider. However, reference to the rider's positioning is merely the result of the structure and configuration of the snowmobile, in particular, the seat, steering device and footrests. To make clear that the claims do not claim a rider, *per se*, they have been amended to recite, e.g., that "the seat is dimensioned to support a standard rider in a standard position in which the rider's legs straddle the seat when the snowmobile is heading straight ahead on that terrain." See, e.g., claim 1. The claimed seat that positions the standard rider in the standard position is as accurate as the subject matter permits, and is therefore proper. *See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ 1081 (Fed. Cir. 1986). The steering device and the footrests, where appropriate in some cases, have also been amended in result oriented format.

Further, Applicants position regarding the claiming of a vehicle in relation to the rider's center of gravity is supported by case law. For example, in *Ex parte Brummer*, 12 USPQ2d 1653, 1655 (Bd. App. 1989), the Board of Patent Appeals and Interferences (Board) considered a claim directed to a bicycle in which the bike's wheel base was defined as a function of a height of the rider that the bicycle was designed for. The claim also defined the

seat position as a function of the rider's center of gravity. Notably, these claims were not rejected under 35 U.S.C. §101. Instead, the Board affirmed the Examiner's rejection based on indefiniteness (under 35 U.S.C. §112, 2<sup>nd</sup> paragraph) because there was no evidence that there was a known standard in the field of bicycle manufacturing for sizing a bicycle to a rider. The present claims have no such indefinite language, i.e., regarding fitting a rider to a snowmobile. The §112 rejection was also affirmed because, unlike the present case and the *Banyan* case, *supra* (in which the patent-at-issue identified in the specification, the dimensions of the standard human thigh), Brummer's rider did not have a specified build.

There are numerous valid patents that define various vehicles (i.e., statutory subject matter) in relationship to the invention's human riders. *See* U.S. Patent No. 5,355,826 (copy enclosed) which defines a snowmobile in terms of the rider's positioning on the snowmobile. *See also* U.S. Pat. No. 3,913,929, claim 1 ("the *center of gravity of said cycle with the rider* in said rider support means, lies below said plane") (emphasis added); *see also* U.S. Pat. No. 5,908,078, claim 1 ("substantially parallel to the ground at the height of the *center of gravity of the vehicle and rider assembly*"") (emphasis added); U.S. Pat. No. 6,109,633, claim 12 ("a tube extending above the *center of gravity of the bicycle and rider*") (emphasis added); U.S. Pat. No. 5,577,750, claim 1 ("having a *combined center of gravity when mounted by a bicycle rider*...such that said pole mounting *means is located near said combined center of gravity*") (emphasis added); U.S. Pat. No. 4,893,579, claim 1 ("said hull being configured such that said hull assumes a generally upwardly inclined *position when riders are seated in tandem on said rear seat* and said hull is travelling forwardly at speed and in a substantially horizontal condition when said watercraft is not travelling and *riders of approximately equal weight* are seated respectively on said forward and rear seats at approximately equal distances from said bridge.") (emphasis added). Therefore, withdrawal of the rejection of claims 1-39, and any

other claims defining an apparatus in terms of the rider's center of gravity is respectfully requested.

Also, the present Examiner (Examiner Boehler) has issued at least 70-80 patents that define an apparatus (mostly land vehicles) in terms of a rider, a user, an operator or a person. Some of the relevant portions of these patents are attached. For example, claim 1 of U.S. Patent No, 5,501,476 recites:

...means for receiving at least a portion of a user's thigh at a position of the user's leg between the user's knee and the user's hip, the means comprising...means for receiving the back of the user's thigh such that contact with the back of the user's thigh is made and the means for receiving the back of the user's thigh is moved by the hip extension motion of the user..."

Many of these patents, including the 476 patent, define a steering position, seating position and footrest position in a way that is not distinguishable from Applicants' claims, especially as amended.

Further, within the context of the rejection under 35 U.S.C. §101, the Office Action states that every rider is different, so that it would be impossible to determine the scope of the claim based on an unspecified rider. Applicants traverse this basis for rejection since all of the claims call for a standard rider who has a specified build according to the specification. Moreover, the Examiner's statement seems related to 35 U.S.C. §112, 2<sup>nd</sup> paragraph, not 35 U.S.C. §101, and is therefore misplaced. The rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph's discussed below.

Further, Applicants respectfully traverse the rejections under 35 U.S.C. §101 regarding use of the term seat position, steering position and foot rest position. Even if these positions were defined solely in relation to the human body, which is not the case, the rejection would still be improper, given that each of the claims is drawn to a snowmobile having mechanical components, i.e., statutory subject matter.

However, the seat position, steering position and foot rest position are all defined in terms of the snowmobile. For example, claim 40 defines a seat that defines the seat position, a steering device that defines a steering position, and a footrest that defines a footrest position. The seat, steering device and footrest are part of the snowmobile, not the rider.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-58, 60, 61, and 64-83 were rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. This rejection is respectfully traversed.

With respect to each of the independent claims, the term "straddle-type" has been changed to --straddle--.

Further, each of the claims was amended (in the June 22, 2000 Amendment) to recite a standard rider, which is defined in the specification. Applicants' definition of a standard rider is definite - it likely would have been acceptable to the Board of Appeals in *Ex parte Brummer*, and it is even better defined than the human thigh feature at issue in *Banyan*, both discussed above. Further, not only is a standard rider defined in the claims, but the standard position of the rider is defined in the claims. The standard position is being added to specifically address the Examiner's comments that even if a standard rider was defined, which it is, the standard rider could assume different riding positions. See page 7 of the Office Action. The standard position is supported the original specification, as agreed during the personal interview. For example, the specification states that the positioning of rider 26 shown in Fig. 1 is considered standard, just as the positioning of the rider 126 in Fig. 2 is considered standard for that snowmobile, as defined by Applicants. As noted by the Examiner, this position is the position of a rider a few seconds after starting the vehicle, headed straight ahead on flat terrain. See page 9, second full paragraph.

In the claims, e.g., claims 1, 6 and 36, the center of gravity of the snowmobile with the rider is defined in terms of the standard rider in the standard position. Specifically, claims 1, 6 and 36 recite that the seat is dimensioned to support a standard rider in a standard position in which the standard rider straddles the seat while the snowmobile is headed straight ahead on flat terrain. Claim 1 also specifies that the snowmobile has a first center of gravity without the rider and a second center of gravity with the rider in the standard position. Each of the claims specifically mentioned in the rejection, i.e., claims 16, 20, 26, 30, 36, 40, 44-46, 55, 61, 64, 77, 81 and 82, as well as claims 54 and 58, has been amended in this respect for clarity only.

Finally, the rejection of claim 1 and all other claims including the term "about" is rendered moot since that term was eliminated from all claims in the June 22, 2000 Amendment.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 40, 41, 44-49, 63, 69-76 and 81-83 were rejected under 35 U.S.C. §102(b) over Yasui. This rejection is respectfully traversed.

Yasui does not teach the subject matter of claim 40. Claim 40 is directed to a snowmobile that includes a frame and a straddle seat disposed on the frame that is dimensioned to support a standard rider in a standard position in which the standard rider straddles the seat while the snowmobile is heading straight ahead on flat terrain. The snowmobile further includes an engine disposed on the frame in front of the seat.

A steering device is disposed on the frame and spaced forward of the seat such that, when the rider grasps the steering device, the rider's torso is tilted toward the steering device and the rider's arms extend toward the steering device with the rider's elbows substantially over the rider's knees and feet.

A footrest is disposed below each side of the seat. Each footrest is dimensioned and configured with respect to the seat and the steering device to support a rider's foot thereon so that the rider's thighs are substantially parallel to ground.

For the standard rider in the standard position, the seat defines a seat position, the steering device defines a steering position, and the footrests define a footrest position. These three positions define specific angles that are recited in claim 40.

Yasui does not teach a seat that is dimensioned to support a standard rider positioned on the seat in a standard position in which the standard rider straddles the seat while the snowmobile is heading straight ahead on flat terrain, a steering device that is disposed on the frame and is spaced forward of the seat such that, when the rider grasps the steering device in the standard position, the rider's torso is tilted toward the steering device and the rider's arms extend towards the steering device with the rider's elbows substantially over the rider's knees and feet, and a footrest dimensioned and configured with respect to the seat and the steering device to support a rider's foot so that the rider's thighs are substantially parallel to ground.

In Yasui, the rider is in a cramped position because the snowmobile is "small". The footrest are not dimensioned with respect to the steering device and the seat so that the rider's thighs are substantially parallel to ground. Instead, the footrest are dimensioned with respect to the seat and the steering device such that the rider's thighs angles downwardly toward the front of the snowmobile. Further, the steering device is disposed such that the rider's torso is substantially erect, rather than being tilted toward the steering device. Also, Yasui's steering device is disposed such that the rider's elbows are substantially over the seating position, rather than substantially over the rider's knees and feet. Yasui's snowmobile is miniature in size and its seat, steering position and footrests are not designed, dimensioned or configured with respect to one another such that the rider assumes the position specified in claim 40.

Further, Examiner Boehler, during the personal interview, stated that the rider could slide back in the Yasui seat to arrive at the subject matter of claim 40. Applicants disagree since the Yasui rider would no longer be positioned in the standard riding position, as claimed. Yasui's standard riding position is that position shown in Fig. 1 of Yasui. For example, if Yasui's rider were to slide rearwardly on the seat, the rider would no longer be able to move his/her leg between the starter and the footrest, as shown in Fig. 1 of Yasui. Stated differently, sliding the Yasui rider rearwardly on the Yasui seat might arguably meet some features of the claims, but other features of the claims would no longer be satisfied.

Similar remarks apply to claims 44-46, 81 and 82. Further, with respect to claim 44, Yasui does not teach that a distance between vertical lines passing through the steering position and the seat position is between 40-90 cm, which feature is in claim 64 and was not rejected on prior art.

Further, Yasui does not teach or suggest a steering position that is forward of the forward-most axle of the drive train. In Yasui, the forwardmost axle 29 is positioned forward of the steering position. In Fig. 1, a pulley 28 that is associated with the forward-most axle 29 (Fig. 2) is positioned forward of the steering position. See new claim 84, which, incidentally, does not refer to a rider.

Further, claims 63 and 69-72 are canceled in order to advance prosecution of this application.

With respect to claim 73, Yasui does not teach combination of snowmobile which includes right and left sideboards that are disposed at an angle with horizontal that is between  $0^\circ$  and  $-5^\circ$ , and left and right toe-holds disposed above the rider's toes for allowing the rider to release to secure himself from the snowmobile. In Yasui, even if the forwardmost portion of the foot rest is considered to be a toe-hold, which it is not, that portion is not above the

rider's toes, as specified in claim 73. As mentioned above, the proposed position of the toe-holds 145 in Figs. 2 and 3 is supported by the present specification.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 50 and 54-56 were rejected under 35 U.S.C. §102(b) over Marier. By this Amendment, claims 50, 54 and 56 are canceled. With respect to claim 55, Marier does not teach that a line between the steering position and the seat position forms an angle with a line between the seat position and the top of the windshield that lies between 10 and 20°. In Marier, the angle between the top of the windshield and the steering position as measured from the seating position is no more than about 5°. This subject matter was previously contained in canceled claim 56. Thus, the finality of the Office Action should be withdrawn for this additional reason because Marier does not teach the subject matter of original claim 56, which is now in independent claim 55.

Accordingly reconsideration and withdrawal of the rejection are respectfully requested.

Claims 51-53 were rejected under 35 U.S.C. §103(a) over Marier in view of Yoshioka. However, this rejection is rendered moot in view of the cancellation of claims 51-53.

Claims 59-61 were rejected under 35 U.S.C. §103(a) over Husted in view of Boyer. However, as discussed above, neither Husted nor Boyer teaches or suggests the subject matter of independent claims 59-61, including an engine disposed on the frame in front of the seat. Accordingly, withdrawal of the rejection is respectfully requested.

Claim 62 was rejected under 35 U.S.C. §102(b) over Karpik. This rejection is moot in view of the cancellation of claim 62.

Claims 42 and 43 were rejected under 35 U.S.C. §103 over Yasui. However, claims 42 and 43 depend either directly or indirectly from independent claim 40. Yasui does not teach the subject matter of claim 40, as discussed above. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all of the claims are patentable and that the entire application is in condition for allowance.

However, should Examiner Boehler believe that anything further is desirable to place the application in better condition for allowance, she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Attachments:

U.S. Patent No. 5,355,826

Copies of selected portions of Patents issued by Examiner Boehler

Request for Approval of Drawing Corrections

Selected portions of case law